Customer No. 24498
Internal Docket No. PA040012
Office Action Date: 12/8/2009

Remarks / Discussion of Issues

In the final Office action dated December 8, 2009, it is noted that claims 1-10 are pending and claims 1-10 stand rejected.

By this response, claims 1, 6, and 7 have been amended to clarify certain aspects of the claimed invention. Claims 9 and 10 are canceled herein, and claim 11 is newly added. Support for claim 11 can be found at least at page 7, lines 17-27 of the specification as originally filed. No new subject matter is added.

Cited Art

The art cited and applied in the present Office action includes: U.S. Patent 6,078,328 to Schumann et al. (hereinafter referenced as "Schumann"), and U.S. Patent 7,046,260 to Frimout et al. ("Frimout").

Rejections under 35 U.S.C. §102

Claims 6-8 stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Frimout.

In order for a reference to anticipate a claim, the MPEP 2131 requires the reference to teach every element of the claim. According to MPEP 2131, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

It is respectfully submitted that Frimout does not anticipate claim 6.

Applicants' independent claim 6 recites:

> Device for generating a menu for a video recording medium, the menu showing a thumbnail representative of a recording on the video recording medium and being coded according to a standard using base pictures and predicted pictures, the device having a predefined intra-coded picture memory, a representative picture memory, an encoder for generating an inter-coded picture based on the output of the intra-coded picture memory and containing change

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<u>information between the output of the intra-coded picture and the thumbnail</u>, and a recording unit equipped to record the predefined intra-coded picture and the inter-coded picture onto the recording medium. (Emphasis added.)

In the Response to Arguments section on pages 3-4 of the final Office action, the Office alleges that Frimout discloses certain embodiments of the claimed invention at column 3, lines 19-31 and also at e.g. column 3, line 66 through column 4, line 19. The Office further suggests that claim 6 is grammatically incorrect because it is unclear to the Office the meaning of the term "as basis" with respect to the output of the intra-coded picture memory.

Claim 6 is amended herein to clarify certain aspects of the claimed invention. First, the claim eliminates the term "as basis" for clarification purposes. Also, Claim 6 requires an encoder for generating an inter-coded picture based on the output of the intra-coded picture memory and containing change information between the output of the intra-coded picture and the thumbnail.

The Office suggests that Frimout's "background" data reads on the claimed "predefined intra-coded picture data" and the "key frame picture data" of Frimout reads on the claimed "inter-coded picture." However, Applicants respectfully submit that these aspects of Frimout do not anticipate claim 6.

Beginning at column 3, line 61, Frimout suggests an assembling unit for assembling a background picture and a scaled encoded key frame. Frimout's assembling operation is reportedly performed by replacing entire slices of the encoded background picture with new slices representing the scaled key frame picture. An appropriate slice grid is selected for the background picture, and the key frame picture is reportedly scaled appropriately within slice boundaries so that the scaled key frame picture can be inserted or replaced into the background picture.

Frimout's operation is completely different from the claimed invention because the background picture of Frimout is not based on the output of Frimout's key frame and containing change information between the output of the key frame picture and the thumbnail. Nowhere does Frimout disclose or suggest generating an inter-coded picture based on the output of the intra-coded picture memory and containing change

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information between the output of the intra-coded picture and the thumbnail. Rather, Frimout's key frame allegedly relies on the background frame to the extent of slice boundaries so that the scaled key frame picture can be inserted into the background picture. Furthermore, Frimout does not disclose or suggest a thumbnail or its equivalent. As such, Frimout does not disclose the significance of change information between the output of an intra-coded picture and the thumbnail. Therefore, Applicants respectfully submit that the rejection of claim 6 under 35 U.S.C. §102(e) has been traversed as per MPEP 2131 and requests the withdrawal of the rejection to claim 6.

Each of dependent claims 7 and 8 depend upon and incorporate all the features of allowable claim 6. Furthermore, dependent claims 7 and 8 include additional distinguishing features. Applicants essentially repeat the above arguments from claim 6 and apply them to dependent claims 7 and 8. Thus, Applicants respectfully submit that dependent claims 7 and 8 are allowable at least by virtue of their dependency on claim 6.

Applicants respectfully submit that the rejection of claims 6-8 under 35 U.S.C. §102(e) has been traversed and respectfully request the withdrawal of the rejection of these claims.

Rejections under 35 U.S.C. §103

Claims 1-5, 9, and 10 stand rejected as allegedly being unpatentable over Schumann in view of Frimout. Applicants respectfully traverse these rejections.

Applicants' claim 1 recites:

> Method for generating a menu for a video recording medium, the menu showing a thumbnail representative or a recording on the video recording medium and being coded according to a standard using base pictures and predicted pictures, the method having the steps of
> - starting with a predefined intra-coded picture including predefined blocks,
> - generating an inter-coded picture having no change information for blocks of the inter-coded picture corresponding to the predefined blocks, and having change information for selected blocks containing the thumbnail, and
> - storing both the predefined intra-coded picture and the inter-

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> coded picture as menu information on the video recording medium.
> (Emphasis added).

In the Response to Arguments section on pages 2-3 of the final Office action, the Office alleges that the combination of Schumann and Frimout discloses all elements of claim 1. The Office suggests that Schumann's encoding P-frame reads on the "generating" feature of claim 1 since Schumann allegedly discloses generating P-frames and because these P-frames allegedly contain blocks comprising "change" information for predefined/selected blocks. The Office further explains its position on page 7 of the Office action, alleging that Schumann implements an I-frame as a base image which is added to a temporary P-frame and combining them to form a menu item. The Office relies on Frimout for disclosing a new menu picture being encoded and recorded to an appropriate area on the disc which allegedly reads on the "storing" feature of claim 1.

Applicants respectfully submit that the combination of Schumann and Frimout does not read on claim 1.

Schumann discloses a compressed digital video graphics system where a base image is allegedly produced by an I-frame formed by modifying the I-frame or by overlaying the I-frame with a P-frame. However, Applicants respectfully submit that Shumann does not disclose generating an inter-coded picture having no change information for blocks of the inter-coded picture corresponding to the predefined blocks, and having change information for selected blocks containing the thumbnail, as required by claim 1. Although Schumann, at for example column 5 lines 13-18, discloses a method for constructing a P-frame that allegedly contains graphics elements containing pre-compressed macroblocks, Schumann's P-frame, in contrast to claim 1, has change information for all blocks in relation to its I-frame. Schumann does not disclose or suggest an I-frame with predefined blocks and constructing a P-frame having no change information for blocks which correspond to the predefined blocks of the I-frame.

This embodiment of the claimed invention offers the advantage of using smaller block areas for each recording because the inter-coded picture is generated such that it has no change information for blocks which correspond to predefined blocks of the

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intra-coded picture and having change information for selected blocks of the inter-coded picture which contain the thumbnail. To illustrate more clearly, a non-limiting example of an application of the claimed invention would include coding a picture that has a thumbnail on a background. In this example, the predefined intra-coded picture may be the background. And the inter-coded picture would be generated having no change information for blocks which correspond to predefined blocks (the background) and having change information for selected blocks (the thumbnail). As such, this embodiment of the claimed invention offers the advantage of not requiring the background information to be stored multiple times. For example, for subsequent frames that contain a different thumbnail on the same background, only the new thumbnail needs to be encoded and stored.

Schumann does not disclose generating an inter-coded picture having no change information for blocks of the inter-coded picture corresponding to the predefined blocks, and having change information for selected blocks containing the thumbnail. Frimout does not cure the deficiencies of Schumann with respect to claim 1. Accordingly, Applicants respectfully submit that the rejection of claim 1 under 35 U.S.C. §103(a) has been traversed.

Furthermore, the Office alleges that the combination of Schumann and Frimout discloses storing both the predefined intra-coded picture and the inter-coded picture as menu information on the video recording medium. As pointed out above, neither Schumann nor Frimout, separately or in combination, disclose the generated inter-coded picture of the claimed invention. Accordingly, neither reference can disclose storing the inter-coded picture.

In addition, neither Schumann nor Frimout, separately or in combination, disclose the predetermined intra-coded picture. Therefore, Schumann's and Frimout's alleged intra-coded picture and inter-coded picture cannot both be stored as menu information.

Dependent claims 2-5 depend ultimately upon allowable claim 1. Each dependent claim incorporates all of the respective features of claim 1, from which they depend, in addition to containing further distinguishing patentable features. Therefore, for at least the same reasons discussed above with respect to claim 1, the

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combination of Schumann and Frimout does not teach or even suggest all the features of claims 2-5. Claims 9 and 10 are canceled herein.
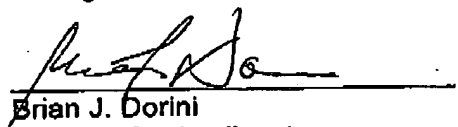
Accordingly, withdrawal of the rejection to claims 2-5, 9, and 10 under 35 U.S.C. § 103(a) and early allowance of the claims is respectfully requested.

Conclusion

Having fully addressed the Examiner's rejections it is believed that, in view of the preceding amendments and remarks, this application stands in condition for allowance. Accordingly then, reconsideration and allowance are respectfully solicited. If, however, the Examiner is of the opinion that such action cannot be taken, the Examiner is invited to contact the Applicants' attorney at (609) 734-6817, so that a mutually convenient date and time for a telephone interview may be scheduled.

Please charge any required additional fee or credit any overpayment to Deposit Account No. 07-0832.

Respectfully submitted,
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